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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,363	10/27/2000	Toivo T. Kodas	SMP-004-4-1	3474

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EXAMINER	
NILAND, PATRICK DENNIS	
ART UNIT	PAPER NUMBER
1714	5

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

8N - 5

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P ri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 10/27/00.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 104 - 167 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 104-115, 117-134, 136-147, and 150-166 is/are rejected.

☒ Claim(s) 116, 135, 148, 149, and 167 is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s)._____

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Revi w, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other_____

Office Acti n Summary

1. The amendments of 10/27/00 have been entered. Claims 104-167 are pending.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 104-115, 117-134, 136-147, and 150-166 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5616165 Glicksman et al.. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of the instant claims and the patented claims overlap such that they encompass each other and the patented claims are expected to inherently give gold particles possessing the parameters of the instant claims since the methods are so similar, as evidenced by the patentee's figure of the product resulting from the claimed process and the patentee's description of what is expected to result from the patent's claimed process. It is expected that some degree of gold oxide necessarily forms at the surface of the resulting particles where strongly oxidizing conditions are used in the patented method. Equilibrium dictates that there will be an equilibrium between the dissolved and non-dissolved gold compounds such that there will be two phases which meet the gold metal precursor and non-

metallic second phase limitations limitations of the instant claim 122 as the gold metal precursors of the patentee are non-metallic salts which also falls within the scope of the instant claims 130-133. Equilibrium also dictates that some metal oxide will be present given that this is the precursor to the salts of the patentee, which falls within the scope of the instant claim 134. Since the aerosol method of the patentee clearly gives particles having the properties of those of the instant claims, it is expected that the instantly claimed aerosol parameters are inherently used by the patentee's method.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> > (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> >
> > (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> > (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 104-115, 117-134, 136-147, and 150-166 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 5616165 Glicksman et al..

Glicksman et al. makes their gold particles by the same method disclosed in the instant application. The patentee gives no specific measurements regarding the resulting gold particles. However, since the method of the patentee falls within that disclosed by the instant application, it is expected to yield the same gold particles. See the figure of the patentee. The burden is on the applicant to show that the particles of the method of the patentee do not inherently possess the instantly claimed parameters of the process aerosol and of the final product because the patentee is silent as to these parameters, the PTO has no facilities to make such determinations, and the same method is expected to yield the same particles as the instant claims. See the entire disclosure of the patentee, including the drawings and photographs.

The applicant has previously argued that the instant application requires strict control over the aerosol to give the claimed narrow particle size distribution. The patentee does disclose the use of various nebulizers and controlling the concentration of the droplets to as to retain a narrow particle size distribution. See column 2, lines 45-50 and 57-67 and column 3, lines 1-6. The applicant has not demonstrated that the narrow particle size distribution of the patentee does not fall within the scope of the instant claims inherently. The PTO has no facilities to perform experimentation. The burden to do so is therefore placed upon the applicant. For these reasons, this rejection is maintained.

7. Claims 104-167 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5616165 Glicksman et al. in view of US Pat. No. .

Glicksman et al. makes their gold particles by the same method disclosed in the instant application. The patentee gives no specific measurements regarding the resulting gold particles. However, since the method of the patentee falls within that disclosed by the instant application, it is expected to yield the same gold particles. See the figure of the patentee. The burden is on the applicant to show that the particles of the method of the patentee do not inherently possess the instantly claimed parameters of the process aerosol and of the final product because the patentee is silent as to these parameters, the PTO has no facilities to make such determinations, and the same method is expected to yield the same particles as the instant claims. See the entire disclosure of the patentee, including the drawings and photographs.

The applicant has previously argued that the instant application requires strict control over the aerosol to give the claimed narrow particle size distribution. The patentee does disclose the use of various nebulizers and controlling the concentration of the droplets to as to retain a narrow particle size distribution. See column 2, lines 45-50 and 57-67 and column 3, lines 1-6. The applicant has not demonstrated that the narrow particle size distribution of the patentee does not fall within the scope of the instant claims inherently. The PTO has no facilities to perform experimentation. The burden to do so is therefore placed upon the applicant.

8. Claims 116, 135, 148, 149, and 167 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art considered does not provide rationale for using the additional compounds of the above claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

November 14, 2001

Patrick Niland
Primary Examiner
Art Unit 1714